

REMARKS/ARGUMENTS

Re-examination and favorable reconsideration in light of the above amendments and the following comments are respectfully requested.

Claims 1 – 46 are pending in the application. Currently, claims 1 – 32 and 46 have been allowed and claims 33 – 45 have been rejected.

By the present amendment, claim 33 has been amended to change the word “translated” in the first line of the last paragraph to “converted”. This amendment is made solely for purposes of clarification and not for any reason related to patentability. As will be discussed hereinafter, the novelty and unobviousness of claim 33 lies elsewhere.

In the office action mailed August 12, 2003, claims 33 – 45 were rejected under 35 U.S.C. 251 as being an alleged improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. Still further, in said office action, claims 33, 35, 36, 38, and 40 – 44 were rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,659,764 to Sakiyama et al.; and claims 34, 37, and 45 were rejected under 35 U.S.C. 103(a) as being unpatentable over Sakiyama et al. in view of U.S. Patent No. 5,163,081 to Wycherley et al.

The foregoing rejections are traversed by the present invention.

Independent claim 33 as presented herein is directed to an electronic communications system which allows a hearing impaired person to communicate with others. As part of this system, there is a receiver for receiving spoken words and phrases, means for transforming the spoken words into equivalent signing content and then into textual material and means for outputting the textual material for display on a device utilized by the hearing impaired person. Advantageously, and most uniquely, the *device* utilized by the hearing impaired person includes means for receiving words and phrases from the hearing impaired person. These words and phrases can be transformed into a form which may be presented to a hearing person. Thus, Applicant has invented a very powerful and useful tool which can be used by the hearing impaired to communicate with people in everyday situations. For example, the device used by the hearing impaired person could be a laptop computer which receives a question asked by a teacher in a classroom, converts it into a form to be viewed on the laptop screen by the hearing

impaired person, and then allows the hearing impaired person to respond in a way which can be aurally presented to the teacher.

Without question, there was a failure of the patent attorney in the application which led to the '853 patent to appreciate the full scope of the invention during the prosecution of the original patent application. Thus, the instant reissue patent application is more than warranted.

There is also no question that the prosecution of the parent application revolved around the claimed video apparatus for visually observing the images of facial and hand and finger signing motions and converting the observed signing motions into digital identifiers. This is because all of the system claims filed in the original application began with the video apparatus. However, the amendments and arguments presented in the parent application do not operate as a surrender which leads to the application of the recapture rule in this case. In fact, the recapture rule is believed to be inapplicable in this case.

Claims of the scope of claim 33 were never presented during the prosecution of the case which lead to the '853 patent. The Examiner has not pointed, and can not point, to any such independent claim. There was never a rejection of a claim directed to the novel and unobvious features of claim 33, namely the device used by the hearing impaired person to view a textual display, also including means for receiving words from the hearing impaired person, because no such claim was ever presented. There was never a patentability argument presented based upon the novel and unobvious features of claim 33, again because no such claim was presented. Thus, there never was any surrender of the novel and unobvious aspects of claim 33.

The recapture rule does not apply in the absence of evidence that an applicant's amendment was an admission that the scope of that claim was not in fact patentable. See *Seattle Box Co. v. Industrial Crating & Packing Inc.*, 221 USPQ 568, 574 (Fed. Cir. 1984). The amendments, as well as the arguments, made in the application which led to the '853 patent had absolutely nothing to do with the subject matter for which protection is now sought by claim 33 and thus can not operate as an admission that a claim of the scope of claim 33 was unpatentable. While claim 33 is broader in a certain aspect, that aspect, i.e. the claimed device, is unrelated to the rejections in the application leading to the '853 patent. Thus, the recapture rule does not bar the claim. See *In re Clement*, 45 USPQ2d 1161, 1165 (Fed. Cir. 1997).

For these reasons, the rejection of claims 33 – 45 under 35 U.S.C. 251 should be withdrawn.

With regard to the rejection over Sakiyama et al, Sakiyama et al. fails to teach or suggest the “means for outputting textual material for display on a device utilized by a hearing impaired person”, which device includes “means for receiving words and phrases from the hearing impaired person.” The outputting means in Sakiyama et al. is the monitor 7 which lacks any means for receiving words and phrases from the hearing impaired person. There is a microphone 1 however it is used by a hearing person and does not form part of the monitor 7. It should be noted that the Sakiyama system is not designed to perform two way communication in the manner of the present invention. For these reasons, claims 33, 35, 36, 38, and 40 – 44 are allowable over Sakiyama et al.

The rejection of claims 34, 37, and 45 on obviousness grounds is duly noted. However, Wycherley et al. does not overcome the deficiencies of the Sakiyama et al. patent. Claims 34, 37, and 45 are allowable for the same reasons as their parent claims as well as on their own accord.

The instant application is believed to be in condition for allowance. Such allowance is respectfully solicited.

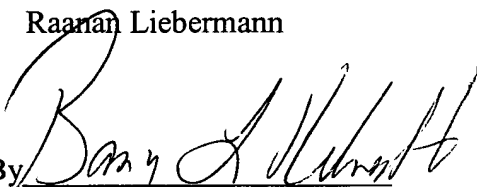
Should the Examiner believe an additional amendment is needed to place the case in condition for allowance, she is hereby invited to contact Applicant’s attorney at the telephone number listed below.

Appl. No. 09/603,247
Amdt. dated Nov. 11, 2003
Reply to office action of Aug. 12, 2003

No fee is believed to be due as a result of this response. Should the Commissioner determine that a fee is due, he is hereby authorized to charge said fee to Deposit Account No. 02-0184.

Respectfully submitted,

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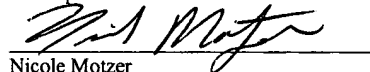
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Date: November 11, 2003

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313" on **November 11, 2003**.


Nicole Motzer